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### REMARKS

Applicants appreciate the Office Action of June 3, 2005. In particular, Applicants appreciate the Examiner's indication that Claims 12-25, 27-29, 31 and 35-37 would be allowable if rewritten in independent form. Applicants have amended Claim 1 as set out above to include recitations from previously pending Claim 5. Dependent Claim 5 has been cancelled from the present application and dependent Claims 6 and 30 have been amended to conform the dependency thereof to the cancellation of Claim 5. Applicants submit that amended independent Claim 1, independent Claim 34 and the claims that depend therefrom are patentable over the cited references for at least the reasons discussed herein.

#### The Section 102 Rejections

Claims 1-2, 5-11 and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent Publication No. 2004/0023697 to Komura (hereinafter "Komura"). See Office Action, page 2. Applicants respectfully submit that many of the recitations of these claims are neither disclosed nor suggested by Komura. For example, Claim 1, which has been amended to include the recitations of dependent Claim 5, recites:

A mobile terminal comprising:  
a housing;  
an electronic circuit positioned in the housing;  
a first speaker positioned adjacent a first side of the electronic circuit;  
a second speaker positioned adjacent the first speaker on the first side of the electronic circuit; and  
a grommet positioned in the housing that is configured to receive the first speaker and the second speaker, wherein the first speaker and the second speaker are positioned in the grommet.

Applicants submit that at least the highlighted recitations of amended Claim 1 are neither disclosed nor suggested by Komura.

The Office Action states, in rejecting Claim 5, that the following portion and corresponding figures of Komura teach the highlighted recitations of amended Claim 1. See Office Action, page 2. As stated in Komura:

[0200] FIG. 19 is a view showing a schematic structure of a eleventh embodiment of a

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sound reproducing system in a portable information terminal according to the present invention, and FIG. 20 is a schematic constitutional view of A-A' section involving acoustic loudspeakers 2a and 2b in FIG. 19 viewed from a direction of the arrow.

[0201] As shown in the present figure, in comparison with FIG. 1, acoustic loudspeakers 2a and 2b are disposed on the front of a portable information terminal 1 in such that both surfaces of the acoustic loudspeakers 2a and 2b coincide with a surface of the portable information terminal 1, these loudspeakers 2a and 2b are aligned horizontally, and they are positioned between a screen display monitor 11 and a key panel 12.

*See* Komura, paragraphs 200-201. In other words, the cited portion of Komura discusses, and the corresponding figures illustrate, first and second loudspeakers 2a and 2b disposed on the front of the portable information terminal 1 between a screen display monitor 11 and a key panel 12. Nothing in the cited portion of Komura discloses or suggests a grommet as recited in amended Claim 1. In fact, nothing in Komura appears to mention the use of a grommet in any of the embodiments discussed therein.

Under 35 U.S.C. § 102, "a claim is anticipated only if each and every element as set forth in the claim is found, *either expressly or inherently* described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" M.P.E.P. § 2112 (citations omitted). Thus, since nothing in Komura discloses or suggests a grommet, this silence does not establish inherency. Furthermore, nothing in Komura appears to suggest the use of a grommet.

Accordingly, Applicants respectfully submit that amended Claim 1 is patentable over Komura for at least the reasons discussed herein. Furthermore, the dependent claims are

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patentable at least per the patentability of independent amended Claim 1 from which they depend.

Many of the dependent claims are also separately patentable. For example, Claim 6 recites:

The mobile terminal of Claim 1 wherein the grommet is configured to provide a seal between a front face of the first speaker and a back face of the first speaker and between a front face of the second speaker and a back face of the second speaker.

The Office Action points to paragraphs 131 and 136 of Komura as teaching the recitations of Claim 6. See Office Action, page 3. The cited portion of Komura discusses the diagonal position of the acoustic loudspeakers 2a and 2b and the functional result thereof. Nothing in the cited portion of Komura discloses or even suggests a "seal" or a "grommet" as recited in Claim 6. Furthermore, as discussed above with respect to Claim 1, nothing in Komura appears to discuss a grommet at all. It follows that a seal provided by a grommet as recited in Claim 6 is also not disclosed by Komura. Accordingly, dependent Claim 6 is separately patentable over Komura for at least these additional reasons.

Dependent Claim 7 recites:

The mobile terminal of Claim 6 wherein the housing comprises a front face including a keypad and an earpiece and wherein the first speaker and the second speaker are positioned between the electronic circuit and the front face and wherein the electronic circuit comprises a printed circuit board, the mobile terminal further comprising a first passageway acoustically coupling the front face of the first speaker to the earpiece.

The Office Action points to paragraphs 147-151 of Komura as teaching the first passageway acoustically coupling the front face of the first speaker to the earpiece as recited in Claim 7. See Office Action, page 3. The cited portion of Komura discusses the angle defined between the acoustic loudspeakers 2a and 2b. Although the figures of Komura may illustrate passageways, nothing in the cited portion of Komura discloses or suggests or even discusses a passageway acoustically coupling the front face of the first speaker to the earpiece as recited in Claim 7. Accordingly, dependent Claim 7 is separately patentable over Komura for at least these additional reasons.

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Dependent Claim 8 recites:

The mobile terminal of Claim 7 further comprising a seal between a first face of the grommet and the front face of the housing and a seal between a second face of the grommet and the first side of the printed circuit board.

The Office Action points to paragraphs 186-189 of Komura as teaching the recitations of Claim 8. See Office Action, page 3. The cited portion of Komura discusses the positioning of the first and second loudspeakers 2a and 2b on the cabinet wall of the portable information terminal and the acoustic effects thereof. Nothing in the cited portion of Komura discloses or suggests or even discusses a "seal" or a "grommet" as recited in Claim 8. It follows that a seal between first and second faces of the grommet as recited in Claim 8 is also not disclosed by Komura. Accordingly, dependent Claim 8 is separately patentable over Komura for at least these additional reasons.

Dependent Claim 9 recites:

The mobile terminal of Claim 7 further comprising a second passageway acoustically coupling the front face of the second speaker to an opening in a face of the housing remote from the earpiece.

The Office Action points to paragraphs 166-169 of Komura as teaching a second passageway acoustically coupling the front face of the second speaker to an opening in a face of the housing remote from the earpiece as recited in Claim 9. See Office Action, page 3. The cited portion of Komura further discusses the positioning of the first and second loudspeakers 2a and 2b. Nothing in the cited portion of Komura discloses or suggests or even discusses a second passageway as recited in Claim 9. Accordingly, dependent Claim 9 is separately patentable over Komura for at least these additional reasons.

Dependent Claim 10 recites, in part, "wherein the grommet defines the first and second passageways." Paragraphs 166-169 are cited again as teaching the recitations of Claim 10. See Office Action, page 3. As discussed above, nothing in the cited portions of Komura disclose or suggest a grommet or first and second passageways. It follows that a grommet that defines the first and second passageways as recited in Claim 10 is

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also not disclosed by Komura. Accordingly, dependent Claim 10 is separately patentable over Komura for at least these additional reasons.

Dependent Claim 30 recites:

The mobile terminal of Claim 1 wherein the grommet comprises:  
a first member configured to receive the first speaker and to provide a seal between a front face of the first speaker and a back face of the first speaker; and  
a second member configured to receive the second speaker and to provide a seal between a front face of the second speaker and a back face of the second speaker.

Paragraphs 190-192 and 97-99 are cited as teaching the recitations of Claim 30. See Office Action, page 4. As discussed above, nothing in the cited portions of Komura disclose or suggest a grommet. It follows that a grommet having first and second members as recited in Claim 30 is also not disclosed by Komura. Accordingly, dependent Claim 30 is separately patentable over Komura for at least these additional reasons.

#### The Section 103 Rejections

##### **A. Independent Claim 34 is Patentable over the Cited Combination**

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Komura in view of United States Patent No. 3,922,488 to Gabr (hereinafter "Gabr"). See Office Action, page 8. Applicants respectfully submit that many of the recitations of Claim 34 are neither disclosed nor suggested by the cited combination. For example, Claim 34 recites:

A speaker assembly comprising:  
a grommet defining adjacent first and second receiving chambers;  
a first speaker positioned in the first receiving chamber;  
a second speaker positioned in the second receiving chamber; and  
wherein the grommet is configured to provide a seal between a front face of the first speaker and a back face of the first speaker and between a front face of the second speaker and a back face of the second speaker.

Applicants respectfully submit that at least the highlighted recitations of Claim 34 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

The Office Action points to Komura disclosing "wherein the grommet is configured to provide a seal between a front face of the first speaker and a back face of the first speaker and

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between a front face of the second speaker and a back face of the second speaker." *See* Office Action, page 7. However, the Office Action admits that Komura fails to disclose or suggest a grommet defining adjacent first and second receiving chambers, a first speaker positioned in the first receiving chamber or a second speaker positioned in the second receiving chamber. *See* Office Action, page 7. The Office Action points to Gabr as providing the missing teachings from Komura.

As discussed above, nothing in Komura even discusses a grommet. As further discussed above, nothing in Komura discusses a "seal" as recited in Claim 34. Thus, Komura fails to disclose or suggest the recitations of Claim 34 for at least the reasons discussed above with respect to the section 102 rejection. Furthermore, Gabr does not provide the missing teachings.

Gabr discusses a feedback-cancelling electro-acoustic transducer apparatus as recited in the title. The portion of Gabr (Column 1, lines 13-30) cited in the Office Action as teaching the grommet as recited in Claim 34 (*See* Office Action, page 7), discusses acoustic feedback and the causes thereof. Nothing in the cited portion of Gabr discloses or suggests a grommet defining first and second receiving chambers as recited in Claim 34. Similarly, the portions of Gabr (Column 7 and column 8, lines 25-35) cited in the Office Action as teaching the first and second speakers positioned in the receiving chambers as recited in Claim 34 (*See* Office Action, page 7), discusses Figures 8 through 10 of Gabr. Figures 8 through 10 illustrate various microphone units. However, nothing in these figures or the corresponding text disclose or suggest a first and second speakers positioned in first and second receiving chambers defined by a grommet as recited in Claim 34.

Furthermore, there is no motivation to combine the cited references as suggested in the Office Action. As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *See In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against

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its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

The Office Action states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a grommet adjacent receiving chamber as taught by Gabr to the system of Komura in order to reduce the effect of acoustic echoes.

See Office Action, page 7. This motivation is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Office Action does not point to any specific portion of the cited references that would motivate one of skill in the art to combine the cited references as suggested in the Office Action. If the motivation provided in the Office Action is adequate to sustain the Office's burden of motivation, then anything that would "reduce the effect of acoustic echoes" would render a combination obvious. This cannot be the case. Accordingly, the statement in the Office Action with respect to motivation does not adequately address the issue of motivation to combine as stated in *In re Sang-su Lee*. Thus, it appears that the Office Action gains its alleged impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references. Furthermore, even if Komura and Gabr could be properly combined, the combination of Komura and Gabr would not teach the recitations of the claims of the present application for at least the reason discussed above.

Accordingly, Applicants respectfully submit that independent Claim 34 is patentable over the cited combination for at least these additional reasons. Furthermore, dependent Claims 35-37 are patentable at least per the patentability of independent base Claim 34 from which they depend. However, Claims 35-37 are also patentable as they are indicated as containing allowable subject matter in the Office Action. See Office Action, pages 8 and 9.

**B. Many of the Dependent Claims are also Separately Patentable**

Claims 3-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

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Komura in view of United States Patent Publication No. 2003/0095680 to Kim (hereinafter Kim). Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Komura in view of United States Patent No. 5,201, 069 to Barabolak. Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Komura in view of United States Patent Publication No. 2003/0003879 to Saiki. Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Komura in view of United States Patent Publication No. 2002/0042287 to Asami. As discussed above, these dependent claims are patentable at least per the patentability of independent base Claim 1 from which they depend. However, many of these claims are also separately patentable for at least the reasons discussed herein.

For example, dependent Claims 3 and 4 contain recitations directed to the DC resistances of the receiver speaker and the micro-speaker recited in Claims 1 and 2. The Office Action admits that Komura does not specifically disclose the recitations of dependent Claims 3 and 4. *See* Office Action, pages 4 and 5. However, the Office Action points to Kim as providing the missing teachings. The Office Action cites paragraphs 31 and 32 of Kim as teaching the recitations of Claim 3. *See* Office Action, page 5. The cited portion of Kim discusses a combination receiver and speaker having a speaker mode and a receiver mode. Although the resistances in each of these modes is discussed in Kim, nothing in Kim discloses or suggests a receiver speaker and a micro-speaker having DC resistances as recited in Claim 3. Accordingly, dependent Claim 3 is separately patentable over the cited references for at least these additional reasons.

The Office Action states that dependent Claim 4 is "rejected for the same reason set forth in claims 3." *See* Office Action, pages 5. Thus, as discussed with respect to dependent Claim 3, nothing in Kim discloses or suggests a receiver speaker and a micro-speaker having DC resistances as recited in dependent Claim 4. Accordingly, dependent Claim 4 is separately patentable over the cited references for at least these additional reasons.

Furthermore, there is no motivation to combine the cited references as suggested in the Office Action. The Office Action states:

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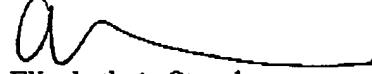
Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the DC resistance of the micro-speaker as taught by Kim to the system of Komura in order to adjust the voice current.

See Office Action, page 5. This motivation is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Office Action does not point to any specific portion of the cited references that would motivate one of skill in the art to combine the cited references as suggested in the Office Action. If the motivation provided in the Office Action is adequate to sustain the Office's burden of motivation, then anything that would "adjust the voice current" would render a combination obvious. This cannot be the case. Accordingly, the statement in the Office Action with respect to motivation does not adequately address the issue of motivation to combine as stated in *In re Sang-su Lee*. Thus, it appears that the Office Action gains its alleged impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references. Furthermore, even if Komura and Gabr could be properly combined, the combination of Komura and Gabr would not teach the recitations of the claims of the present application for at least the reasons discussed above. Accordingly, Applicants respectfully submit that dependent Claims 3 and 4 are separately patentable over the cited references for at least these additional reasons.

#### CONCLUSION

Applicants respectfully submit that the pending claims are patentable over the cited references for at least the reasons discussed herein. Accordingly, Applicants respectfully submit that the pending claims are in condition for allowance, which is respectfully requested in due course.

Respectfully submitted,

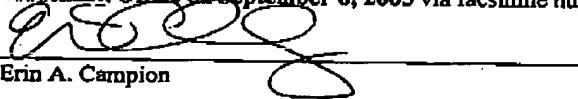
  
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